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No. 08-951

FILED

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OFFICE OF THE CLERK
SUPREME COURT, U.S.

In the
Supreme Court of the United States

OREN TAVORY,

Petitioner,

v.

NTP, Inc.,

Respondent.

On Petition for Writ of Certiorari
to the United States Court of Appeals
for the Federal Circuit

REPLY IN SUPPORT OF
PETITION FOR WRIT OF CERTIORARI

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List of Parties and Corporate Disclosure

The Rule 29.6 corporate disclosure statement included in the Petition for a writ of certiorari remains accurate.

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REPLY BRIEF FOR PETITIONER

Defining the parameters of joint inventorship is an important question of federal law that has not been, but should be, settled by this Court. The Federal Circuit, without this Court's guidance, has created an impossible joint inventorship standard that has all but eviscerated the hope of any measured or fair application of 35 U.S.C. §§ 116 and 256, even though Congress clearly intended to allow co-inventors to be added to a patent after issuance.

This Court has never directly addressed the issue of patent co-inventorship. It should do so in this case because the joint inventorship test used by the Federal Circuit to exclude Tavory from the patents-in-suit conflicts with the legal principles set forth in *KSR International, Inc. v. Teleflex, Inc.*, 550 U.S. 398 (2007) and with 35 U.S.C. §103. The Court in *KSR* held that the novelty and non-obviousness tests apply to the subject matter of a claim "as a whole." The Federal Circuit, however, in the context of determining joint inventorship, applies the novelty and non-obviousness tests to the conception of individual elements of a claim. Pet. App. 8-9.

Similarly, this Court should decide the important federal question of whether the Patent Act, which was designed to protect and incentivize inventors,

destroys those same inventors' rights to be compensated when their co-inventors omit them from the patent and then exclude them from infringement litigation in which they had a legal right to participate.

**I. This Court Should Grant The Writ To
Resolve Ambiguity and Uncertainty in the
Patent Law Regarding What Constitutes
Joint Inventorship.**

"The exact parameters of what constitutes joint inventorship . . . is one of the muddiest concepts in the muddy metaphysics of the patent law". *Mueller Brass Co. v. Reading Industries, Inc.*, 352 F.Supp. 1357, 1372 (E.D.Pa. 1972), *aff'd*, 487 F.2d 1395 (3d Cir. 1973); *Jamestown Corp. v. U.S.*, 518 F. 2d 1384, 1396 (Ct. Cl. 1975). Most courts which discuss this topic admit that the test for establishing co-inventorship under the Patent Act is far from clear.¹ Commentators who have studied the issue of defining co-inventorship note the confusion surrounding a definition of co-inventorship standards. "Inventorship is especially difficult to define when several individuals have participated in a single invention. Both Congress and the courts have struggled to clarify what determines joint

¹ See, W. Fritz Fasse, *The Muddy Metaphysics of Joint Inventorship: Cleaning Up After the 1984 Amendments to 35 U.S.C. § 116*, 5 HARV.J.L. & TECH. 153 (1992) and cases cited therein.

inventorship.” *Id.* Another commentator has explained that “the law of joint inventorship has always had vague guidelines, attaching legal significance to an abstract event, [and] adhering to a metaphysical standard that deems an inventor’s ‘moment of conception’ the badge of inventorship.”²

The Federal Circuit’s test for co-inventorship has been a moving target. In *Pannu v. Iolab Corp.*, 155 F. 3d 1344, 1351 (Fed. Cir. 1998), the Federal Circuit held that “[a]ll that is required of a joint inventor is that he or she (1) contribute in some significant manner to the conception or reduction to practice of the invention, (2) make a contribution to the claimed invention that is not insignificant in quality, when that contribution is measured against the dimension of the full invention, and (3) do more than merely explain to the real inventors well-known concepts and/or the current state of the art.” But the Federal Circuit created and applied an entirely new standard in this case, where it required Tavory to prove that the conception of his contribution to the invention was “more than the result of ordinary skill.” Pet. App. 8, 10.³ The Federal Circuit added further confusion when it concluded that Tavory failed this

² Joshua Matt, Note, *Searching for an Efficacious Joint Inventorship Standard*, 44 B.C. L. REV. 245, 245 (Dec. 2002) at 245-46.

³ “Pet. App.” refers to the appendix to Tavory’s Petition. Citation to “Reply App.” refers to the appendix bound herein.

test by his alleged failure to show that his contribution to the invention was "not in the prior art." Pet. App. 9.⁴ Judge Newman's refusal to join with the reasoning of the majority opinion, which she noted "propounds several purported rules of joint inventorship," Pet. App. 23, is understandable, because the test for co-inventorship articulated below does not appear in any prior judicial pronouncement of a joint inventorship test⁵ and is not found in the Patent Act. Certiorari should be granted to establish a definite test with clear standards.

II. The Court Should Grant the Writ To Correct the Federal Circuit's Erroneous Test for Joint Inventorship.

The Federal Circuit's requirement that a putative joint inventor prove that his contribution to the conception of the invention was more than the exercise of ordinary skill and not in the prior art is inconsistent with the Patent Act and this Court's precedent. The novelty and non-obviousness

⁴ The Federal Circuit clearly overlooked portions of the report of Dr. Kalinsky, which stated that the interface switch was not prior art and, instead, "overcomes the problems and deficiencies in the prior art." Pet. App. 140.

⁵ The majority below cited to *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F. 3d 1456 (Fed. Cir. 1998) to support its articulation of the joint inventorship test. Pet. App. 7. All that the putative joint inventor had to show in *Ethicon*, however, was "what [his] contribution was and then whether that contribution's role appears in the claimed invention." *Id.* at 1461.

requirements of Sections 102 and 103 of the Patent Act apply to the "subject matter [of a claim] as a whole" and not to the individual elements of the claim. *KSR International, Inc. v. Teleflex, Inc.*, 550 U.S. 398, 406 (2007). Moreover, a unique combination of known elements, all of which are in the prior art, may be patentable. *Id.* at 418. Therefore, each joint inventor's contribution may be within the prior art, so long as the subject matter as a whole meets the novelty and non-obviousness requirements. The Federal Circuit's test for joint inventorship articulated below *conflicts* with *KSR* by disqualifying a joint inventor's contribution to the invention if it is in the prior art, even if the claim as a whole is not. In doing so, the Federal Circuit has created a requirement of joint inventorship not found in sections 102, 103, 116 or any other section of the Patent Act.

This Court's admonition in *KSR* to the Federal Circuit to consider the subject matter as a whole, rather than any particular element, in determining obviousness necessarily applies in determining co-inventorship. To require a co-inventor to show that his contribution is not in the prior art makes it all but impossible to prove inventorship. As this Court stated, "inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be

combinations of what, in some sense, is already known." *KSR*, 550 U.S. at 418-19.

NTP makes no attempt to respond to Tavory's challenge to the Federal Circuit's erroneous joint inventorship test, discussed on pages 16 and 17 of the Petition. Instead, NTP argued that Tavory cannot show that he conceived of any of the subject matter of the claims because Tavory at most conceived of a system to send emails wirelessly "to pagers," while the subject matter of the patents at issue is "an integrated wireless electronic mail system." Respondent's Brief at 17-18. This is a distinction without a difference, and in any event was not argued below.

NTP did not argue that Tavory's invention was technologically different because it sent email to a pager. Instead, NTP argued in its Motion for Summary Judgment that Tavory's claimed invention sent text, not email, via a "MessageWriter," which operates through a telephone. Pet. App. 43. The district court, overlooking record evidence, agreed. *Id.* But the Federal Circuit rightfully rejected NTP's argument, recognizing the record evidence that Tavory's invention transmitted "emails" from a "computer terminal." Pet. App. 11. NTP has not challenged the Federal Circuit's conclusion. It cannot now morph its losing argument into an argument not asserted in its dispositive motion and

to which Tavory has never been given an opportunity to respond factually.

NTP's rebuttal of Tavory's challenge to the Federal Circuit's refusal to find sufficient corroboration of Tavory's conception to survive summary judgment by the undisputed evidence of Tavory's reduction to practice is based entirely upon a misstatement of the facts. NTP's representation that the evidence shows "at most" that "Tavory wrote software code dated November 25, 1990 as part of the AT&T laptop commercialization effort" and this was after Campana had "demonstrated the invention at a national trade show"⁶ completely ignores the record evidence that Tavory conceived of and reduced to practice the interface switch well before November 1990.

Nearly all of the eleven disinterested witnesses testified that they saw Tavory demonstrate his ability to send an email to his pager using his invention soon after Tavory started at Telefind in late 1989 or early 1990. Pet. App. 114-152. Specifically, the record evidence includes testimony from co-workers and colleagues that corroborate that in late 1989 or early 1990: (1) Tavory "came up with the idea" of sending emails wirelessly to a pager; (2) shortly thereafter, Tavory "took it upon himself to

⁶ Brief in Opposition at 19.

make emails magically appear on peoples pagers"; and (3) "Tavory [was] congratulated at Telefind for "creating and inventing the wireless email system." Petition at 6-9, 21-23 (explaining timing of Tavory's invention). The AT&T laptop project had not even begun at the time Tavory conceived and reduced the interface switch to practice A. 119-23. Thus, NTP's attempts to characterize Tavory's contribution as nothing more than his having "assisted" in reducing to practice Campana's inventive concept for an interface switch completely disregards the timing laid out in the third-party testimony.

**III. The Writ Should Be Granted so this Court
Can Determine the Preemptive Scope of
Section 262 and the Viability of Unjust
Enrichment Claims Between Co-Inventors.**

This Court also should resolve the second important joint inventorship question of whether 35 U.S.C. § 262 bars an omitted co-inventor from recovering the portion of the profits unjustly obtained by the named co-inventors through infringement litigation from which the omitted joint inventor was excluded. Section 262 does not, by its terms, bar such a recovery, but the Federal Circuit has construed § 262 to preempt recovery under state law and to foreclose recovery under federal law.

The lack of remedy faced by Tavory is an inequitable consequence of the long-recognized rule

that all owners of a patent must be joined in any infringement action. See *Willingham v. Star Cutter Co.*, 555 F.2d 1340, 1343 (6th Cir. 1977)(citing *Waterman v. MacKenzie*, 138 U.S. 252, 255 (1891)). There are three important interests protected by this requirement:

- (1) the interest of a co-owner in being able to license third parties under his or her patent without harassing suits by other co-owners; (2) the interest of a co-owner in avoiding the estoppel effect of a judgment declaring the patent invalid in which he or she did not participate; and (3) the interest of a defendant in avoiding multiple suits.

Willingham, 555 F.2d at 1344. By depriving a newly-added co-inventor of any remedy against his co-owners who excluded him from infringement litigation from which they profited, the Federal Circuit undermines the important policy concerns met by the joinder requirement that date back over a century.

Section 262 does not require this inequitable result. As explained in the Petition (at Part. II), Section 262 is *silent* as to this factual scenario: It speaks only to situations where co-owners decide to "make, use, offer to sell, or sell the patented invention ... or import the patented invention." 35 U.S.C. § 262. Absent from this statutory text is any discussion of what a co-owner's duties are in the case

of enforcement. For a century that gap has been filled with the requirement of joinder of all owners to an infringement action. It is only logical that the failure to join a co-inventor in such litigation by omitting such inventor from the patent is an unjust enrichment to a patent owner prevailing in such litigation. Given the incentive that inventors have to omit co-inventors from the patent, an equitable remedy is even more critical.

NTP relies strongly on its assertion that the legislative history -- and in particular, a proposed version of Section 262 that was not enacted and a committee report explaining it -- shows that Congress rejected the notion of a co-owner being unjustly enriched by enacting Section 262. However, "failed legislative proposals are a particularly dangerous ground on which to rest an interpretation" of a statute. *Central Bank of Denver, N.A. v. First Interstate Bank of Denver, N.A.*, 511 U.S. 164, 187 (1994) (internal citations omitted). Given this Court's definitive statement that non-enacted bills "deserve little weight in the interpretive process," *id.* at 165, the Court should give no weight to NTP's arguments based upon that purported history.

This Court should clarify that Section 262 does not preempt common law unjust enrichment. Equity should allow omitted co-inventors to recover their fair share from those who chose to omit them. The

Federal courts have the power to act as courts of equity whenever such a remedy was historically available from a court of equity. *Grupo Mexicano de Desarrollo S.A. v. Alliance Bond Fund, Inc.*, 527 U.S. 308, 333 (1999). There is no question that both federal and state courts routinely apply equity to correct situations where a party has been unjustly enriched by its behavior. This Court must make clear that Section 262 will not protect a co-owner from the consequences of litigating without a joint owner.

IV. This Court Should Reject NTP's Attempt To Avoid the Legal Issues Presented in Tavory's Petition Through its Misleading Statement of the Facts.

NTP, unable to defend the erroneous legal standards applied in this case, argues instead that the *facts* do not warrant review. However, the "facts" as presented in NTP's opposition brief are primarily extra record argument (See Brief in Opposition at 6-9) that the Federal Circuit expressly struck from the briefing below.⁷ Reply App. 1-3. NTP's continued focus upon matters outside the record to attack the

⁷ Even if NTP's version of the facts was accurate, the impossible standards created by the Federal Circuit would still warrant review by this Court. As this Court recognizes, its job is to ensure that the facts, whatever they are, are applied to the correct legal standards. See, e.g., *Ernst & Ernst v. Hochfelder*, 425 U.S. 185 (1976)(determining legal standard for liability under securities laws).

credibility of Tavory's record evidence strongly suggests that NTP realizes its summary judgment cannot be defended on this record.

NTP also grossly misrepresented the content of record evidence. The unsubstantiated statement on page 5 of the Brief in Opposition that Tavory "emphatically disavowed (over 100 times) knowledge concerning the conception and reduction to practice of the inventions," is false. No one asked Tavory during his 2002 deposition who invented the Push technology. Instead, Tavory was shown code (the Push software attached to the patents-at-issue) which he wrote twelve years earlier and asked repeatedly whether he wrote it. Reply App. 6-7. Tavory testified at least seven times that he wrote that code. Reply App. 6-7; 13; 19; 20; 27; 28; 29; 34; 36. Tavory also testified that he was one of the persons who "figured out basically how to take the e-mails and send them from the email system to the pager." *Id.* at 28.

NTP's attack on Tavory's three hour deposition in 2002 (his only participation in the RIM litigation) is misleading. Tavory sat for deposition without having seen or discussed the Push software or any related documents for more than a decade. Reply App. 11-12, 20. Tavory, who did not have a lawyer, had never attended a deposition and knew nothing about patents, did nothing to prepare for his 2002

deposition. *Id.* at 17, 23. Even though no one explained to Tavory before or during his deposition why he was there or what the suit was about, NTP now argues that Tavory should have deduced that it was a suit over the validity of patents built upon technology he helped to invent. That argument is misplaced on a motion for summary judgment in which inferences must be drawn against the moving party.

NTP's attempt to characterize Tavory as an opportunist who recently fabricated his co-inventor claim because he did not assert it until after NTP obtained a substantial settlement from RIM and after Tom Campana died is completely undermined by the record evidence that *in 1990* Tavory claimed to have invented the technology that pushes emails to the Telefind paging network and that *in 1990* he was widely recognized at Telefind as the inventor of that technology. See Petition at p. 6-9. This was long before the Push technology enjoyed any commercial success and 14 years before Campana died.

V. The Equitable Defenses of Laches and Estoppel, Raised by NTP for the First Time in Response to the Petition, Do Not Require Denial of this Meritorious Petition.

NTP never moved for summary judgment on laches and estoppel as to the patent inventorship claims, and the District Court made no findings on

that issue. Pet. App. 25-44. Judge Newman relied on findings of fact regarding copyright ownership, not patent, in arguing that there was an alternative basis for upholding a summary judgment opinion that she clearly felt was not legally correct. (Pet. App. 36-37; 22-24).

Conclusion

This Court should grant the Petition to create a clear, consistent standard for determining joint inventorship that complies with the provisions and intent of the Patent Act, the Constitution and this Court's precedent. Granting the writ would also provide a remedy to an omitted co-inventor who has been denied the right to participate in the infringement litigation by which the named inventors profited.

Respectfully Submitted,

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** Counsel of Record*

App. 1

NOTE: This order is nonprecedential.

**United States Court of Appeals
for the Federal Circuit**

2007-1527

OREN TAVORY,

Plaintiff-Appellant,

v.

NTP, INC.,

Defendant-Appellee.

Appeal from the United States District Court
for the Eastern District of Virginia in
case no. 3:06-CV-628, Judge James R. Spencer.

ON MOTION

Before DYK, *Circuit Judge*.

ORDER

(Filed Mar. 19, 2008)

Oren Tavory moves for clarification concerning the contents of the appendix. NTP, Inc. responds. Tavory replies.

Tavory requests clarification whether certain attorney notes cited by NTP as A2033-34 are part of the record. Tavory states that the attorney notes were the subject of a discovery dispute before the district court but were never filed with the court. NTP responds that the notes were submitted to the district court for

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in camera review in connection with a motion to compel, and that the district court ordered production. Thus, NTP asserts, "there is no dispute that Judge Spencer reviewed these documents and that they formed part of the body of knowledge for his various decisions at issue."

Pursuant to Fed. R. App. 10, the record on appeal is confined to, inter alia, papers and exhibits filed in trial court. Because NTP argues only that the notes were reviewed to determine whether they were subject to a discovery request and not filed with the district court, the notes are not part of the record on appeal. Thus, they were properly excluded from the joint appendix and should not have been cited by NTP in its brief.

Tavory further states that the items designated by NTP as A2035-96 were not filed in the district court. In its response, NTP states that it believes these pages should have been included in the joint appendix and indicates that it will be submitting a motion to supplement the joint appendix with respect to these pages.

The court determines that NTP has not shown that A2035-96 are part of the record on appeal. Thus, they were properly excluded from the joint appendix and should not have been cited in NTP's brief.

Because NTP's brief includes citations to items that are not part of the record on appeal, NTP is directed to file a replacement brief omitting citations to A2033-96. Furthermore, because Tavory's reply

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brief sought to strike references to these pages and NTP's replacement brief will omit the citations, Tavory is directed to file a replacement reply brief omitting arguments seeking to strike these citations.

Accordingly,

IT IS ORDERED THAT:

(1) The motion for clarification is granted to the extent that the court clarifies that A2033-96 are not part of the record on appeal.

(2) NTP is directed to file a replacement brief omitting references to A2033-96 within seven calendar days of the date of filing of this order.

(3) Tavory is directed to file a replacement reply brief omitting arguments seeking to strike NTP's references to A2033-96 within seven calendar days of the date of filing of this order.

Mar. 19, 2008
Date

/s/ Timothy B. Dyk
Timothy B. Dyk
Circuit Judge

cc: G. Donovan Conwell, Jr., Esq.
James H. Wallace, Jr., Esq.

App. 4

IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
RICHMOND DIVISION

Case No. 3:01 CV 767

NTP, INC.,

Plaintiff,

vs.

RESEARCH IN MOTION, LTD.,

Defendant.

VIDEO DEPOSITION OF OREN TAVORY

Taken before Arthur Blaustein, Notary Public in
and for the State of Florida at Large, pursuant to
notice of taking deposition filed by the Defendant in
the above cause.

Monday, September 23, 2002
100 South Ocean Boulevard
Manalapan, Florida
5:41-9:30 p.m.

* * *

[22] A. No.

Q. Did you go to any additional schooling after
the University of Miami?

A. No. I mean I have taken, I think, computer
courses from like different manufacturers, you know,
how to have classes and stuff like that, but not any

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formal kind of thing, if you are looking for a degree, no.

Q. Like a Microsoft?

A. Yes, things of that nature.

Q. Have you ever heard of a company called ESA?

A. I think that is where Tom Campana, I think, had worked or originally owned. I'm not sure but I think that was the other company.

Q. Have you ever met Tom Campana?

A. Yes, I have met him, I think, like three or four times. I think when he was down at the office a couple of times.

Q. Have you ever met him up in - ESA was located in Chicago, if I'm correct.

A. I think that I had a trip up there once. I think.

Q. Did you ever meet Gary Thelen?

A. I met somebody, I think, when I was up there. I don't remember his name. A gentleman had, I [23] think, black or brown hair and a moustache.

Q. How about Michael Ponschke?

A. That name sounds familiar. I think I have met him but I can't say for sure.

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Q. Okay. We will get to some documents here in a little while that will help.

How about have you ever met anybody from the AT&T Safari computer?

A. I think I met one gentleman there, an Indian gentleman, I think one time. That is the only one – again, I think we did a trip one time there and I think that's when I went up to Chicago or wherever it was.

Q. Okay. We'll take you back a few years.

A. No problem.

MR. NELSON: Let's have this marked as Exhibit – actually, I'll just hand it to you.

I'm handing the witness what's marked as Ponschke Exhibit 6.

BY MR. NELSON:

Q. And Mr. Tavory, if you would take a look at that and take a few minutes to thumb through it.

The first part is very difficult to read. The part I'm more interested in is easier to read later on, so.

[24] A. All right.

Q. I'm going to ask you, first of all, to turn to page ten of Exhibit 6, and ask you to look at what begins on page 10 and goes to Page 14, and once you have looked at that, my question is if that's the computer code that you wrote.

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I will point you to page 13 where it says: Author: Oren Tavory in the box.

A. It looks like it. I can't tell you for sure but it looks like it.

Seems to have certain style to it, so I will probably say yes. To the best of my recollection, yes.

Q. Just looking at this style, is it the style of code writing that you tended to use?

A. Yeah, looks like it. I mean the way I look at it is, for example, my comments, I usually say "Mod" and so on. That seems to be. I can't tell you for the rest, line by line, no offense. I have to look at it but it seems to be.

Q. Looking at page – the author, it says Oren Tavory. There is no reason you believe that is not you.

A. You got it.

MR. LYONS: You are referring to page 13.

[25] THE WITNESS: I'm referring to page – specifically, he said started at 10 through 13. On page 13, it looks like on page 13 it has the title up there that seems to, modification by Oren, the description, the author, the date, modification history. I usually try to keep those kind of things in there. That seems to be.

BY MR. NELSON:

Q. Looking at the whole group of code from 10 to 13, I'll focus you on page 10, about three quarters of the way down the bottom it says "MOD BY OT 11/29/90."

A. That seems to be, again, when I make modifications, I try to report it and things like that so it seems that that is something that I have done.

Q. So the record is clear, Ponschke Exhibit 6 page 10 through 14, you have no reason to believe that you did not author that code.

MR. LYONS: Objection to form.

THE WITNESS: I have no reason to believe that this is not the code that I wrote or authored or whatever.

You guys want to go ahead and argue about it.

[26] BY MR. NELSON:

Q. Okay. To deal with counsel's objection, do you believe you wrote the code on pages 10 to 14?

A. I do believe so.

Q. Looking at the top of page 10, it says "Copyright Telefind Corporation 1990."

Do you see that?

A. Yep.

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Q. Did you do this work for Telefind Corporation?

A. I was hired by them at that time, yes.

Q. Did you have an employment agreement with Telefind Corporation?

A. I can't tell you. It's been so long. No offense. I didn't keep any pieces of paper or anything like that so I can't tell you.

You might want to look at their personnel record. Maybe they have something.

Q. If you could look at just the first box that's between "Copyright Telefind Corporation" and the first sort of starred box in the middle of the page.

A. Uh-huh.

Q. Look at that code and can you tell me what that block of code does, what function it performs?

A. Starting with Mark end of the command line?

Q. Yes.

A. Seems to - hold on. Seems to execute a Unix command that's got something loaded inside it. Probably some kind of shell script or something of that nature.

Q. Looking down now at this box in the middle of the page that says functions, arguments, descriptions

App. 10

and returns, what do you mean by, where you say function there?

A. A function usually in a program is a certain subroutine that gets executed so you would, for example, inside your code, think about it being sequential, and it would say, Go ahead and do this routine, execute that, and then come back here.

Q. So the code would say go do "X."

A. And when you're done with "X," come back and "X" does this particular –

Q. "X" would be a function. Okay.

A. Correct.

Q. What about arguments?

A. Arguments are variables you pass to a function and this basically allows you, so you don't have to hard-code the function, you can go ahead and pass certain information to the function so it will [28] act differently depending on what you're passing to it.

Q. What about the description portion of that box that says description?

A. Sounds like it's reading in some information and putting it into a ray or buffer or something of that nature.

Q. And what about returns?

A. Returns is when a function finishes, it usually will tell the other parts of the program whether

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it was successful or not, and usually returning a value depending on that is what determines that.

Q. This box we have just been talking about in the middle of page 10, does that relate to the code that is written above it or the code that is written below it?

A. It looks like it seems to be toward the part below it because it says function: Getline, and then below it is the getline function.

Q. Okay.

Looking at the next group here, the next group of code on page 10 to the box starting on page 11, could you tell me what that portion of code does?

A. From 10 to the beginning of page 11.

[29] Q. Yes. Basically the bottom portion of page 10.

A. It seems to get a character from a file until there's the end of file and loaded into a character pointer or a character ray, from what I can see just initially.

MR. LYONS: Could I have the answer back, please?

(Answer read.)

THE WITNESS: Again, I haven't had time to sit here and ponder all the code here and so on but from what I can see in the first minute or two, you

are asking me, this is what I can tell you that it seems to do.

BY MR. NELSON:

Q Okay. That's all right. We can take more time to ponder it later as well.

MR. LYONS: I will object to the whole line in terms of speculation.

BY MR. NELSON:

Q Looking at the sort of the bottom portion of page 10, it says backslash star MOD by OT 11/29/90. Do you see that?

A Uh-huh.

Q What does that modification relate to?

* * *

[34] mail user would have to have his name registered and then converted to the appropriate ID. If his name is not registered with Telefind, you must send your message back to the sender indicating a nondeliverable message."

Do you recall programming the 3B2 computer at Telefind in any way relating to this sort of a function?

MR. LYONS: Objection to form.

THE WITNESS: I think the 3B2, from what you are telling me, seems to be the main frame, and I was programming. I can't tell you whether I have done these or not.

Again, I cannot remember any of these items.

BY MR. NELSON:

Q. Did you ever do any programming to take an e-mail from an AT&T mail system and convert it in such a way that it could be sent to the Telefind paging network?

A. I think that's what it did. I think the e-mails would come in and they would get essentially turned into pages.

Q. Did you write software code to help that process happen?

A. Yep, I do believe so.

[35] Q. Looking back at Ponschke Exhibit 6, pages 10 through 14, does that code relate to that project?

MR. LYONS: Objection to form.

THE WITNESS: I can't remember but it looks like it does.

BY MR. NELSON:

Q. Do you have any reason to believe that it does not?

A. No.

Q. When you were writing the code to convert the AT&T mails into - well, strike that for a minute.

Where did you get the messages – where did the AT&T messages arrive at?

MR. LYONS: Objection to form.

THE WITNESS: I think on the main machine.

BY MR. NELSON:

Q. And when you say main machine, what was the main machine?

A. Again, I cannot tell you specifically whether –it sounds like it's this AT&T or three or whatever it is that you're mentioning now.

Q. When you say main machine, you mean computer.

A. The quote/unquote main computer, the Unix system, whatever that happens to be.

[36] If you are telling me that it's an AT&T three, whatever, then I don't know. That's the best I can tell you.

Q. Looking again at the Ponschke Exhibit 13, where it says, So, in Telefind's 3B2," is that an acronym? Could that be the main machine?

MR. LYONS: Objection to form.

THE WITNESS: Could be.

MR. NELSON: Strike that one. I'll ask a different question.

BY MR. NELSON:

Q. Did Telefind have other main computers or just one?

MR. LYONS: Objection to form.

THE WITNESS: That, I can't remember, whether it was one or many.

BY MR. NELSON:

Q. I'll hand you what's been marked as Ponschke Exhibit 8 and I'll ask you to look through that document.

Take your time and look through it.

A. Okay. What's the question?

Q. Okay. The first question is, who was Robin Roberts?

A. That, I don't remember.

[37] Q. Do you know if he was a Telefind employee?

A. I have no recollection on that one. Seems to be, from where it says in the heading but that name just doesn't even conjure up anything.

Q. Looking at the third page of the document, it's NTP0007973, the little numbers in the lower right, and about halfway down that page, a little bit more, there's a thing in bold and it says issues and then there's a number one.

And it says, When will the encoding of the header be available?

And it says in bold 4/12/91 and in parentheses, Oren, afterwards.

Are you the Oren that's referred to there?

MR. LYONS: Objection to form.

THE WITNESS: Probably.

BY MR. NELSON:

Q. Do you know if Telefind had any other employees named Oren?

A. No, I don't think they had any other employees there named Oren.

Q. Did you do any programming relating to modifying the header information on an AT&T e-mail that was coming into the Telefind system?

MR. LYONS: Objection to form.

* * *

[54] BY MR. NELSON:

Q. Take some time and look through it.

A. I can't remember that far back so it's not going to - looking at it is not going to change the picture as far as that goes.

Looks like it's meant to go do something of that nature. I can't tell you for sure that is it or the exact specific things.

If you want me to sit here and look at it, it's your time.

Q. Let me hand you something else to see if that will help at all.

A. Okay.

Q. I'll hand you what's been marked as Ponschke Exhibit 1.

MR. NELSON: Do you want a copy of this or no?

BY MR. NELSON:

Q. The first thing I'm going to ask you, Ponschke Exhibit 1 is titled "United States Patent 5436930.

Have you ever seen that document before?

A. No.

Q. If you will look at the top there is column numbers after the drawings.

[55] A. Okay.

Q. Look at column 43 and 44, if you would.

A. Okay.

Q. And I want you to compare what starts about two-thirds of the way down column 43 and 44, where it says backslash star mark the end of command line you built so that you can add any

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delimiters star backslash, about two-thirds of the way down?

A. Okay. You want me to compare that to.

Q. I want you took compare that to what starts on page 10 of Exhibit 6.

A. What page?

Q. Starting on page 10.

My question is, is it the same code?

A. There's a couple of functions there but am I missing something? I don't know if I am looking at the right place or not.

Here is the getline from this function here and that's on this page here.

There's a function that you are looking at here that says ticks.

Q. You are looking up a little too high.

If you will look at the patent starting right here, backslash, with your code starting up here on page 10, backslash star mark.

[56] A. Seems to be identical.

Q. Look over at the next page here of – it would be columns 45 and 46 and do the same comparison to the next page. It would be sort of the middle of page 10 of Exhibit – of Ponschke Exhibit 6, and then going on to page 11.

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A. Seems to be the same.

Q. Do the same thing for going over into columns 47 and 48 and continuing on upon Exhibit 6, pages 11 and 12.

A. Seems to be.

Q. So based on your comparison, you conclude that you wrote the code that appears in Ponschke Exhibit 1 from beginning on column 43 and 44 and concluding at column 47, 48?

MR. LYONS: Objection to form.

THE WITNESS: Seems that my name that says modification by OT over here so the answer is yes.

BY MR. NELSON:

Q. Would you draw a line across Exhibit 1 to delineate the portion of the code that you wrote from the portion of the code above that?

A. One more time the question. I'm sorry.

Q. Ponschke's Exhibit 1, column 43 and 44, [57] contains a page of computer code and based on -

A. Hold on one second. Let me start over here so I can understand what you are saying.

Okay. Column 43 and 44.

Q. Contains the full page of computer code.

A. Uh-huh.

Q. Based on your comparison, you indicated that you wrote a portion of that code.

A. Uh-huh.

Q. Can you draw a line delineating the portion that you wrote from that which you did not write?

A. I don't remember which part I wrote and which ones I didn't.

Q. Look again at Exhibit 6 where you did write, starting at page 19.

A. I will give it my best guesstimate here.

Q. Okay.

A. The best that I can guess.

Do you want this?

Q. Okay. I guess - let me ask you, the portion that you marked that is below return paren out dot, X dot, DX, close paren, semiconductor, is that the portion below that that you believe you wrote?

A. Yes.

Q. Okay.

* * *

[66] Q. More than 50 percent?

A. I can't even remember back again what transpired day-by-day ten years ago.

Q. So your testimony under oath is that you basically did two things while you were at Telefind but you don't have any idea how much time you spent doing either one.

A. Absolutely. I can't remember. If you can tell me how much time you spent on this and this case from ten years ago, you have my congratulations. I can't. Nothing personal towards you but that's the answer.

Q. Okay.

A. I'm sorry. I'm not trying to be a wiseass or anything like that. I don't want to -

Q. How long have you known Tom Campana?

A. I don't know him very well. I've met him three, four times.

That's about my extent of interaction with Tom Campana.

Q. When was the first time you met him?

A. I can't tell you specifically but I met him while I was employed over there.

Q. Was the first time you met him in connection with this work between AT&T and Telefind?

[67] A. I can't remember that. I don't remember the first time I even met him so I can't tell you.

Q. You don't know one way or the other?

A. One way or the other I can't tell you. I think we met three, four times, and I think one time in Chicago and I think when we went up for this thing, and the other thing, I met him a couple of other times down in Telefind when he came down.

Q. When is the last time you recall speaking to him?

A. I can't remember that. I know I didn't speak with him after I left.

Q. After you left Telefind?

A. Did not speak with him afterwards.

Q. Have you ever spoken with Gary Thelen, to your knowledge?

A. I don't remember that name.

Q. How about Michael Ponschke?

A. Again, I think that's when I was up there in Chicago, I think I met Michael Ponschke there but that's about my extent of remembering interaction with him.

Q. When you did the programming that's in Exhibit 6, did you work from scratch or did you work from materials that you got from somebody else?

[68] MR. LYONS: Objection to form.

THE WITNESS: I worked from scratch, if I can remember right.

I don't think there was anything at that time that did this.

BY MR. NELSON:

Q. Do you know Don Stout?

A. No. The only other name I could remember, I think, was the owner named Andy something.

Q. Andros?

A. Could be. I think he was a Greek gentleman.

Q. Are you represented by counsel in this case?

A. No, I'm not.

Q. Have you talked to lawyers for Mr. Campana?

A. I do believe that they have called me and just like you have called me and I have told both sides that, no offense, I don't want to be on anybody's side. I am here to tell pretty much what I can remember and I didn't want to take, no offense, assistance from your or from the other side, either one.

Q. Who did you talk to at – what were the lawyers' names you spoke with?

A. That, I don't remember. I got a phone call one night and that was the first time I heard it.

[69] And I do believe I spoke recently with a gentleman, I don't know if it was you or somebody over there from your firm.

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I think I also spoke with you. You had a gentleman, a private detective or somebody, who did something and I basically told both sides, I have to be honest, guys, ten years ago, I don't remember what transpired.

That's what I have said to both parties. Whether it's good or bad to either one, I can't tell you. Don't get me wrong. That's between you guys and the judge to find out.

All I can tell you is what, the best to my recollection, which is not much.

Q. Turn to Ponschke Exhibit 1. That's the patent again. And look at column 29, the top of it.

A. Okay.

Q. Just read it to yourself, first.

A. Okay.

Q. Let me know when you're done.

A. You don't want me to read the code.

Q. No, just the test.

Starting at the column 29, the text reads:

The program on pages 10 through 12 of the appendix implements the function of the interface

* * *

[102] marked as Ponschke Exhibit 17.

Take a look through that document and my question is have you ever seen it before?

A. Not that I can remember.

Q. Have you seen documents similar to it in the context of your programming experience at Telefind?

MR. LYONS: Objection to form.

THE WITNESS: No. It looks more hardware than software.

MR. NELSON: Okay.

BY MR. NELSON:

Q. I'm handing you what's been marked as Ponschke's Exhibit number 18 and take a look through that and my question is have you seen that document before?

A. Not that I could remember.

Q. How about the code that begins on Page 11731?

A. No.

Q. No, you don't remember?

A. Doesn't look like mine and, no, I don't remember it.

Q. Okay.

Let me show you what's been marked as Ponschke's Exhibit 19, and ask you if you have seen [103] that document before.

A. No.

Q. No, you haven't seen it or no, you don't remember if you have seen it or not?

A. I don't remember whether I've seen any of these documents and it doesn't seem like something that I would have seen.

Q. Okay. But you don't know one way or the other?

A. Don't know one way or the other.

Q. You have not been retained by NTP as a consultant in this case in any way?

A. No, I have not.

Q. Or by their law firm?

A. Or by their law firm or by you.

Q. Do you know who Mike Pryslak was?

A. No.

Q. No about Glen Twigs. I may have asked you about him already.

A. No.

Q. When you were working on the software that you developed and you worked on that ultimately – strike that.

Let me start this a different way.

I believe that you testified that at some [104] point the Telefind AT&T project was able to send e-mails from a computer e-mail system to the Telefind pagers.

A. Uh-huh.

Q. Were you responsible for writing the code that allowed a portion of that to happen?

MR. LYONS: Objection to form.

THE WITNESS: Yes, I think so.

BY MR. NELSON:

Q. Which portion of that code at a high level speed, in a high level description were you responsible for?

MR. LYONS: Objection to form.

THE WITNESS: I think it was pretty much taking the message when it came in and then sending it out to the network for the pager to pick up.

BY MR. NELSON:

Q. Where was Telefind located geographically?

A. Down in Miami, in Coral Gables.

Q. Was that where the computers were located as well?

MR. LYONS: Objection to form.

THE WITNESS: I think the main frame was down there.

[105] I can't tell you for all of them.

BY MR. NELSON:

Q. Is that where the main frame computer was located?

A. Yes.

Q. The main frame was a Unix?

A. I think so, yes.

Q. So you were the person that figured out basically how to take the e-mails and send them from the e-mail system to the pager?

MR. LYONS: Objection to form.

THE WITNESS: I was one of those that - there were several parts there but one of them, yes.

BY MR. NELSON:

Q. Who else did you remember was involved in that?

MR. LYONS: Objection to form.

THE WITNESS: I think somebody from Tom Campana's side I think did some of the

programming to actually get e-mail pagers to the pager and stuff like that.

BY MR. NELSON:

Q. Uh-huh.

A. I'm trying to think. There used to be an [106] operations side and stuff like that, and I guess they would manage, I think, some of the stuff out there but I can't really remember all the details, but that one part I think was basically taking the messages to the pager. I did. The other parts I think Tom Campana or somebody up there did the part; for example, once you send a message on to the network and it actually gets to the pager itself, and so on, they would know more than I would about that.

Q. Once the message actually goes out to the paging terminal?

A. Networks, and goes to the network and how it actually goes between.

Q. Hobs and ladders?

A. Whatever it was.

Q. The part you knew about and worked on was what happened when the e-mail came into the system and got converted into whatever it had to be converted to be sent to the paging company.

MR. LYONS: Objection to form.

THE WITNESS: I think generally yes.

BY MR. NELSON:

Q. Can you describe generally what kind of - strike that.

Can you describe generally what kind of [107] transformations the e-mail had to go to from the time it came into the computer at Telefind to make it ready to send it to the pager?

MR. LYONS: Objection to form.

THE WITNESS: I don't remember that.

MR. NELSON: I don't have anymore questions at this time.

MR. LYONS: Okay.

CROSS-EXAMINATION

BY MR. LYONS:

Q. I just have a couple.

A. Okay.

Q. You were shown a number of exhibits today and just answered a couple of questions, but I will go back to Ponschke's Exhibit 1 that you have in front of you. It's the patent.

A. Okay.

Q. You don't recall seeing this document prior to today. Is that correct?

A. I don't think I have ever seen this document prior to today.

Q. And Ponschke's Exhibit 6.

A. Uh-huh.

Q. Exhibit 6.

A. Okay. This one?

[108] Q. No. It's the next one.

A. Here we go.

Q. Prior to today do you recall seeing this document?

A. I want to make sure. No.

Q. And Ponschke's Exhibit 8. The next one, Ponschke's 8?

A. Eight.

Q. Prior to today do you recall seeing this document?

A. No.

Q. I ask you to go to Ponschke's Exhibit 13.

A. Here we go.

Q. Do you recall seeing this document prior to today?

A. No, I don't remember from ten years ago.

Q. I'll ask you the same questions with respect to Ponschke's Exhibit 14.

Prior to today do you recall seeing this document?

A. No.

Q. And with respect to Ponschke's Exhibit 15, prior to today do you recall seeing this document?

A. No.

Q. Mr. Tavory, you were asked a number of [109] questions about your work when you were at Telefind and you are familiar with Tom Campana, correct?

A. Uh-huh.

Q. And his group in Chicago. Is that correct?

A. I don't remember him. I don't remember as much about his group but I remember the name.

Q. You understood they were engineers in Chicago working for Telefind?

MR. NELSON: Objection to form.

MR. LYONS: Let me rephrase.

THE WITNESS: Okay.

BY MR. LYONS:

Q. You were familiar with people in Chicago besides Tom?

App. 33

A. I remember one, Mike Ponschke. The rest I don't remember.

Q. Did you work on assignments from time to time with those people?

A. Yes. There would be assignments and basically the entire company would work so Telefind worked as an entire company and then we would have certain assignments and occasionally I would contact them and they would contact me.

Q. Right. And those were primarily the – you were more the IT department, as you described it, I [110] guess, and they were more the engineering group?

A. They did most of the hardware, I do believe. There may have been some other people who did hardware from Telefind but as I understood in general, yes, they did most of the hardware and I think the software was handled at the Telefind part.

Q. When you worked with them in general, before you would do any of the software code, would you make sure to consult with them to make sure you understood the objective before writing any code?

MR. NELSON: Object to form.

THE WITNESS: That, I can't remember.

BY MR. LYONS:

Q. You don't recall one way or the other.

A. One way or the other, I don't remember.

Q. When you worked with the engineering group was there a give and take going on throughout the process?

MR. NELSON: Objection to form.

THE WITNESS: I can't answer that because I don't remember.

I don't recall the specific meetings and what transpired and the whole environment, quote/unquote, of how things worked. I don't remember that.

[111] BY MR. LYONS:

Q. You don't recall any specific assignments that you undertook on behalf of the engineering group?

A. Specific assignments, no.

Q. Do you have any specific recollection on your role on this Safari project?

A. Basically, I remember that I wrote some program that would help them interface the e-mail system with the paging. That part I remember. And about the details of the laptop or whatever that was spoken about here, I do not remember the specifics.

Q. And you don't recall your interaction with the engineering group in connection with that work.

MR. NELSON: Objection to form.

THE WITNESS: No, I do not remember my interaction specifically about specific things.

MR. LYONS: Let me consult with my people for a moment.

(Discussion held off the record.)

MR. LYONS: Okay. I don't have any other questions.

MR. NELSON: I have a couple of follow-ups just real quick.

[112] REDIRECT EXAMINATION

BY MR. NELSON:

Q. I believe counsel showed you a bunch of exhibits and asked you if you had seen them before today.

A. Yes.

Q. The first one, I think, was Exhibit 6.

MR. LYONS: It was actually 1.

BY MR. NELSON:

Q. Looking back at pages 10 to 14, the code you wrote, you believe at some point you saw that code before today.

A. Yes, but I cannot remember any of this.

The question was -- I want to make sure I'm answering the question correctly.

Do I remember before I walked into this room this code? The answer is no.

Looking at it, it makes me believe that that code, that part that we were talking about from 10 to 13 due to the comments, same modification by Oren Tavory, leads me to believe that that was what I wrote over there. Is that clear?

Q. Looking at Exhibit 8, Ponschke's Exhibit 8, I'm sorry.

(Discussion held off the record.)

[113] THE WITNESS: Your question was?

BY MR. NELSON:

Q. My question was do you have any reason to believe that you did not see this document before today?

A. No, I do not [sic] any reason. I cannot remember but I do not have any reason to believe that I did not see it.

MR. LYONS: Can I have that question and answer back again?

THE WITNESS: I do not remember seeing this document and then the second point was do I believe that I would have gotten documents like this

if they were addressed to me. The answer is there is no reason that I know of that I would not have gotten these documents if they were addressed to me.

MR. LYONS: But 8 isn't addressed to you.

THE WITNESS: I don't know. As far as that goes, I can't tell you one way or the other. The answer is I don't remember.

BY MR. NELSON:

Q. Let me follow-up. If you remember from what Mr. Ponschke said, at least with respect to the entry on 7973, where it has: When will the encoding of the
